



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,213	10/17/2001	Johan Renes	5117US	5776
24247 7590 10/01/2008				
TRASK BRITT				
P.O. BOX 2550				
SALT LAKE CITY, UT 84110				
EXAMINER				
NGUYEN, TRAN N				
ART UNIT		PAPER NUMBER		
3626				
NOTIFICATION DATE		DELIVERY MODE		
10/01/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOMail@traskbritt.com

### Office Action Summary

**Application No.**

09/981,213

**Applicant(s)**

RENES ET AL.

**Examiner**

Tran Nguyen

**Art Unit**

3626

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: 06/26/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice to Applicant***

This communication is in response to the communication filed 08/26/2008.

Pending claim(s): 1-20. Amended claim(s): 9, 12.

It is noted that page 2 of the claims filed 08/26/2008 states "Claims 9, 12, and 17 have been amended"; however, claim 17 does not appear to be amended.

Additional clarification is requested.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/26/2008 has been entered.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 08/26/2008 is entered and considered by Examiner.

***Response to Amendment***

As per the rejection of claim 9 under 35 USC 112, first paragraph imposed in the previous Office Action, this rejection is hereby maintained in view of Applicant's failure to properly traverse this rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claim 9, this claim recites "the two or more natural persons are a cohabiting same sex couple".

The specification discloses: "contracts governing a situation wherein two or more people live together (e.g., a co-habitation agreement between a same sex couple)" (page 3 paragraph 0009).

No further discussion regarding same sex couples is provided in the specification as originally filed.

Therefore, insofar as the "determining", "charging", and "administering" steps are enabled, the specification as originally filed only provides enabling disclosure for these steps in the context of ending a marriage through divorce. The specification does not provide enabling disclosure for these steps in context of a cohabitating same sex couple.

As such, the specification as originally filed does not enable one of ordinary skill in the art to make and use the invention of claim 9.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1-20 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 9, this claim recites a "method" comprising "charging that periodic amount" and "administering the insurance program".

First, these method steps do not require the particulars of another statutory category, i.e. machine, manufacture, composition of matter. Therefore, any structure capable of performing the recited method steps would be reasonably enveloped by the claim.

Second, although the claim recites a "periodic amount" and an "insurance program", these limitations amount to mere data transformation or abstract ideas at

best. Such embodiments do not result in a physical transformation in that a physical thing is transformed to another state.

Therefore, claim 9 is directed towards nonstatutory subject matter.

To properly overcome this rejection, Applicant is suggested to amend the claim to require the particulars of another statutory category in the method steps, and/or produce a physical transformation as the result of performing the method.

As per claims 1-8, 10-20, these claims are rejected for substantially the same rationale as applied to claim 9 above, and incorporated herein.

Additional clarification is requested.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 1-3, 5, 8, 10, 12, 16, 18, 20 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden (Breaking Up Without Going Broke, copy provided in Office Action mailed 08/08/2006) in view of Official Notice and Roberts (4839804).

As per claim 1, Golden teaches a married couple (reads on "living together") (paragraph 15).

As per claim 2, Golden teaches a married couple filing for divorce (reads on "legally married") (paragraph 15).

As per claim 3, Golden teaches a married couple filing for divorce (paragraph 15).

As per claim 5, Golden teaches that divorce insurance is offered as part of legal insurance (reads on "another contract") (paragraph 15).

As per claim 8, Golden teaches the policyholder being party to the divorce (paragraph 15).

As per claim 10, Golden teaches a blackout period (paragraph 18).

As per claim 12, Golden teaches a method (paragraph 15) capable of providing legal insurance (reads on "doing business") (paragraph 15) comprising:

(a) charging \$15 per month (reads on "a periodic amount") to a policyholder for providing legal insurance coverage capable of paying for legal fees (reads on "at least some financial consequences") arising out of a divorce proceeding (reads on "the untimely ending of a contractual relationship between two or more natural persons").

Golden does not teach "by way of computer".

Official Notice is taken that using a computer to calculate an insurance premium is old and well established in the art of insurance underwriting.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of the Official Notice within the embodiment of Golden with the motivation of leveraging the power of technology to provide business improvements.

Golden further teaches:

(a) charging \$15 per month for coverage (reads on "over a period of time") (paragraph 15);

(c) administering the insurance plan (paragraph 15-16).

Golden further teaches providing insurance payout for alimony and child-support payments (paragraph 10).

Golden does not teach "at least some financial consequences... comprise, in addition to legal fees... a child's education".

Roberts teaches providing insurance coverage for a child's education in the event of the death of a parent (column 3 line 6-16).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Roberts within the embodiment of Golden and the Official Notice with the motivation of providing a form of child support (Golden; paragraph 10).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per claim 16, Golden teaches adjusting the premium based on marital history (reads on "changed circumstances") (paragraph 18).

As per claim 18, Golden teaches a monthly premium (paragraph 15).

As per claim 20, Golden teaches a blackout period (reads on "prevent fraud") (paragraph 18).

Claim(s) 4, 11, 14-15, 17 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Official Notice and Roberts as applied to parent claim 1 above, and further in view of Covert (20050038681).

As per claim 4, Goldberg, Official Notice, and Roberts do not teach "combines some financial consequences of the untimely ending of a contractual relationship between natural persons with other financial risks of the two or more natural persons".

Covert teaches providing insurance coverage to spouse and children in divorced families (page 2 paragraph 0036).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Covert within the embodiment of Goldberg, Official Notice, and Roberts with the motivation of providing protection against additional expenses beyond those associated with the divorce (Covert; page 2 paragraph 0032-0033).

As per claim 11, Goldberg, Official Notice, and Roberts do not teach "paid by an entity not being one of the two or more natural persons".

Covert teaches purchasing through an agent or at the order of a court (reads on "not being one of the two or more natural persons").

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Covert within the embodiment of Goldberg, Official Notice, and Roberts with the motivation of providing protection against additional expenses beyond those associated with the divorce (Covert; page 2 paragraph 0032-0033).

As per claims 14-15, Goldberg teaches that the government would pay the legal expenses for poor people (reads on "projected earnings") (paragraph 19).

Goldberg, Official Notice, Roberts, and Covert do not teach charging the periodic amount based on the prospective participant's and spouse's projected earnings.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide government subsidies for divorce insurance within the embodiment of Goldberg, Official Notice, Roberts, and Covert with the motivation of reducing spending for countries already paying for legal expenses of poor people (Golden; paragraph 19).

As per claim 17, Goldberg, Official Notice, and Roberts do not teach "disability of one or more of the natural persons".

Covert teaches providing insurance for the disability of a person (page 2 paragraph 0036).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Covert within the embodiment of Goldberg, Official Notice, and Roberts with the motivation of tailoring premiums to the characteristics of the participant (Golden; paragraph 18).

Claim(s) 6-7, 19 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Official Notice and Roberts as applied to parent claim 1 above,

and further in view of Mooney (Could Insurers Find Bliss In Divorce Market?, copy provided in Office Action mailed 08/08/2006).

As per claim 6, Goldberg, Official Notice, and Roberts do not teach “a payment to the two or more natural persons at an end date of insurance coverage in the event the contractual relationship between the two or more natural persons does not end untimely”.

Mooney teaches providing a cash dividend disbursed after a period of time wherein the insurable event does not occur (page 19 paragraph 12).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Mooney within the embodiment of Goldberg, Official Notice, and Roberts with the motivation of providing an incentive to maintain the marriage (Mooney; page 19 paragraph 12, Golden; paragraph 10).

As per claim 7, Goldberg, Official Notice, and Roberts do not teach “investment on the periodic amounts paid on behalf of said natural persons”.

Mooney teaches structuring the end-term payout like a whole life policy (page 19 paragraph 12).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Mooney within the embodiment of Goldberg, Official Notice, Roberts, and Mooney with the motivation of providing an

incentive to maintain the marriage (Mooney; page 19 paragraph 12, Golden; paragraph 10).

As per claim 19, Goldberg, Official Notice, and Roberts do not teach “investing at least a portion of the periodic amount”.

Mooney teaches structuring divorce insurance like a whole life policy (page 19 paragraph 12).

Official Notice is further taken that investing the premium is old and well established in the art of insurance.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of the Official Notice within the embodiment of Goldberg, Official Notice, Roberts, and Mooney with the motivation of generating a return on the premium for use to pay out claims, preventing the devaluation of money due to inflation, and generating a profit for the insurer.

Claim(s) 9 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Official Notice and Applicant Admitted Prior Art (AAPA).

It is noted that the official notice taken in the previous Office Action is taken to be AAPA because Applicant failed to adequately traverse Examiner's assertion.

As per claim 9, Golden teaches a method (paragraph 15) capable of providing legal insurance (reads on “doing business”) (paragraph 15) comprising:

(a) charging \$15 per month (reads on "a periodic amount") to a policyholder for providing legal insurance coverage capable of paying for legal fees (reads on "at least some financial consequences") arising out of a divorce proceeding (reads on "the untimely ending of a contractual relationship between two or more natural persons").

Golden does not teach "by way of computer".

Official Notice is taken that using a computer to calculate an insurance premium is old and well established in the art of insurance underwriting.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of the Official Notice within the embodiment of Golden with the motivation of leveraging the power of technology to provide business improvements.

Golden further teaches:

(a) charging \$15 per month for coverage (reads on "over a period of time") (paragraph 15);

(c) administering the insurance plan (paragraph 15-16).

Golden further teaches married couples (paragraph 15-16) as well as unmarried couples (paragraph 17).

Golden does not teach "a cohabitating same sex couple".

AAPA teaches that at the time of the invention it was old and well known in the art that some states permitted same sex marriage or same sex civil unions.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of AAPA within the embodiment of

Golden and the Official Notice with the motivation of applying the insurance in this manner for the purpose of helping to control the various costs of divorce (Golden; paragraph 9) and palimony (Golden; paragraph 17).

Claim(s) 13 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Golden in view of Official Notice and Roberts as applied to parent claim 12 above, and further in view of Flagg (6456979).

As per claim 13, Goldberg, Official Notice, and Roberts do not teach "based, in part, on the prospective participant's age and the prospective participant's partner's age".

Flagg teaches calculating an insurance premium based on the participant's age (column 2 line 13-32).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Flagg within the embodiment of Goldberg, Official Notice, and Roberts with the motivation of tailoring premiums to the characteristics of the participants (Golden; paragraph 18).

### ***Response to Arguments***

Applicant's arguments filed 08/26/2008 have been fully considered but they are not persuasive.

As per claim 9, on page 7 Applicant argues "Examiner must provide evidence or technical reasoning that a divorcing non-same sex couple is different than a divorcing same sex couple".

Examiner submits the following references: Rey (Evaluation of Gonadal Function in 107 Intersex Patients by Means of Serum Antimüllerian Hormone Measurement), Slijper (Long-Term Psychological Evaluation of Intersex Children), Al-Attia (GENDER IDENTITY AND ROLE IN A PEDIGREE OF ARABS WITH INTERSEX DUE TO 5 ALPHA REDUCTASE-2 DEFICIENCY).

As is well known in the art at the time the invention was made, Rey teaches that it is very common for human beings to experience genetic discrepancies that render a person an "intersex", a person that exhibits both biological male and female characteristics, including disorders in genital differentiation (page 628 column 2 paragraph 3).

Slijper teaches that intersex children exhibit gender identity disorder and deviant gender roles (Abstract), wherein sex assignment problems emerge from ambiguous genitalia (page 126 paragraph 1-2). As is well known in the art, this is a very controversial problem (page 126 paragraph 2).

Al-Attia teaches that intersex adults encounter social problems, wherein an intersex person enters into a marriage as a female, but the marriage quickly ends after a few days in divorce when the intersex person is found to be male, i.e. both partners were the same sex (page 653 paragraph 2).

Therefore, based on the level of ordinary skill in the art, Examiner submits that it is extremely difficult to determine the true sex of a person. By conforming to the traditional definition of marriage provided by government, the parties involved in the marriage identify themselves as male and female to be eligible for marriage.

Absent this legal definition of marriage between a "man" and a "woman", it is extremely difficult to truly determine the biological sex of each person, and therefore it is extremely difficult to ascertain if a cohabitating couple is of the same or different sex. Based on the depth of the research available in the art, it is clear that biological sex is not a dichotomy, i.e. male vs. female, but is instead a continuum wherein people not clearly male or female are classified as "intersex".

Applicant's disclosure does not contemplate which method Applicant intends to employ to determine the biological sex of each couple. Therefore, one of ordinary skill in the art is burdened with undue experimentation to try various methods to determine the true sex of each couple, including genetic testing and other biological tests, including genitalia identification.

Assuming *arguendo* that it is possible to determine if a cohabiting couple is or is not of the same sex, it is clear that couples that do not fall under the traditional definition of marriage between a man and a woman are subject to extreme social and political discrimination, as is evident by Slijper and Al-Attia.

Even if a couple were biological male-male or female-female, Examiner submits that there exists immense sociopolitical pressure in all cultures to end this same sex practice.

Therefore, the actuarial data available for divorces from traditional marriages do not apply to these couples that deviate from the traditional definition, as is evident by the extremely brief periods of marriage.

As such, it is not evident how Applicant intends to ascertain the actuarial risk of underwriting an untimely ending of a same sex cohabiting agreement.

Examiner further submits Vaughan (Fundamentals of Risk and Insurance).

Vaughan teaches that when a form of insurance is initially established, one of ordinary skill in the art arbitrarily estimates what losses are likely to be. After some time has elapsed and a plurality of policies has been written, claims data is collected for analysis. Based on historical claims data, one of ordinary skill in the art can then use past claims data to more accurately determine the price of insurance, i.e. the premium (page 89 column 2 paragraph 3).

As is common in insurance, much of the actuarial data is available from historical experience; however, in view of the difficulty in determining the true sex of a person and the actuarial risk of relationships of such persons, Applicant has not provided any guidance on the starting point for such arbitrary estimate. Therefore, one of ordinary skill in the art, upon review of the specification as originally filed, must pick a random starting point, issue policies, collect data, and reconcile the starting point with the newly collected data.

Examiner submits that determining the risk and pricing the premium accordingly is a crucial part of insurance.

Therefore, one of ordinary skill in the art would be burdened with undue experimentation in practicing the invention of claim 9 based on the specification as originally filed.

On page 7 Applicant argues "the Office makes this obviousness rejection without even identifying what the level of ordinary skill is". Applicant repeats this argument throughout the Remarks.

If the only facts of record pertaining to the level of skill in the art are found within the prior art of record, the court has held that an invention may be held to have been obvious without a specific finding of a particular level of skill where the prior art itself reflects an appropriate level. *Chore-Time Equipment, Inc. v. Cumberland Corp.*, 713 F.2d 774, 218 USPQ 673 (Fed. Cir. 1983). See also *Okajima v. Bourdeau*, 261 F.3d 1350, 1355, 59 USPQ2d 1795, 1797 (Fed. Cir. 2001). MPEP 2141.03(II).

On page 8 Applicant further argues "the first state to recognize gay marriage, Massachusetts, did not do so until 2004, which would appear to make the official notice inaccurate".

First, page 3 of the previous Office Action reads as follows: "Examiner takes Official Notice that at the time of the invention it was old and well known in the art that some states permitted same sex marriage or same sex civil unions".

Applicant appears to take the Official Notice to mean "gay marriage in the US", whereas the Official Notice actually means "same sex marriage or same sex civil unions" in "some states".

First, it is well known in the art that the many countries in Europe have permitted same sex civil unions prior to the priority date of the instant pending application. Traditionally, Europe has been viewed as being more accepting of nontraditional unions than did the US. For example, Denmark has been recognizing civil unions in 1989. Therefore, the noticed fact is not confined to the US.

Second, assuming that the noticed fact is confined to the US, California has accepted domestic partnerships in 2000. Therefore, the noticed fact is well known in the US to the level of state law.

Third, it is well known in the LGBT community that same sex civil unions are desirable, and such groups have been lobbying the government to enact legislature to that effect for many years prior to 2001. Therefore, the noticed fact is well known in the art as being desirable.

As such, it appears that Applicant demands that the noticed facts be gay marriage in public use in the US prior to 2001.

Examiner respectfully submits that such demand is not supportable based on the previous Office Actions which repeatedly took notice of this fact.

Accordingly, Applicant's submitted reference has been considered, but has been found not to be relevant to the Official Notice. In fact, this reference teaches that the

movement has been lobbying since the early 1970s for gay marriage (page 1 paragraph 1).

Therefore, the noticed fact is considered to be admitted prior art in view of Applicant's failure to traverse the Official Notice in accordance with MPEP 2144.03(C).

As per claim 12, Applicant's arguments on page 10 merely rehash arguments previously addressed above, and incorporated herein.

On page 10 Applicant further argues "There would be no reason to combine Roberts' "one-year renewable term insurance program" used to fund an uncertain cost of a college education with Golden".

Golden teaches providing insurance payout for alimony and child-support payments (paragraph 10).

Roberts teaches providing insurance coverage for a child's education in the event of the death of a parent (column 3 line 6-16).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Roberts within the embodiment of Golden and the Official Notice with the motivation of providing a form of child support (Golden; paragraph 10).

In particular, the proposed combination does not modify the teachings of either Golden or Roberts. Therefore, a combination would have yielded predictable results within the grasp of one of ordinary skill in the art.

On page 10 Applicant further argues "Roberts' goals... "teach away" from the instantly claimed methods, which are meant to enhance the financial security of a family, not hedge against an uncertain college tuition inflation (particularly in the event of death of a parent). *In re Peterson*, 315 F.3d 1325, 1331 (Fed. Cir. 2003)".

First, it is not clear what the relevance *In re Peterson* has with the fact patterns of this case. This case refers to the obviousness of numerical ranges. Additional clarification is requested.

Second, Roberts does not criticize, discredit, or otherwise discourage the solution claimed. Therefore, the applied art do not teach away from the claimed combination. MPEP 2145(X)(D)(1).

Third, it is not clear how college tuition is not related to the financial security of a family. Nevertheless, the motivation to combine comes from Golden, as discussed above, and incorporated herein.

Insofar as "enhance the financial security of a family" is an asserted advantage, Golden teaches providing legal fees for a divorce, thereby providing "financial security" for a family undergoing the divorce.

As such, the asserted advantage does not distinguish the claim from the applied art.

On page 10 Applicant further argues that Golden does not teach "college tuition, let alone the uncertain price of future college tuition".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In particular, Examiner relies on Golden for the teaching of child support. It is known in the art that a parent's obligation to a child also encompasses support for college, as is evident by Roberts.

Therefore, the combined teachings of the applied art suggest the claimed invention.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the uncertain price of future college tuition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Additionally, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In particular, Examiner relies on Roberts only for the teachings of providing insurance coverage to cover a child's education in the event of parental death. The remaining features of Roberts are not relied on in the rejection.

As per claims 4, 11, 14, 15, 17, Applicant's arguments on page 10 merely rehash arguments previously addressed above, and incorporated herein.

On page 11 Applicant further argues "While being potentially useful to the payee spouse, Covert's Family Protector Insurance is different than applicants' claimed method, which can be beneficial to everyone involved".

First, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., providing financial benefits for everyone involved) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Second, assuming *arguendo* that this limitation flows inherently therefrom, while Applicant considers payment to the ex-spouse and/or children of a deceased person are beneficial only to the ex-spouse and/or children, Examiner submits that this payment is also beneficial to the deceased person because that person's ex-spouse and/or children are provided with financial security.

Third, assuming *arguendo* that this payment is beneficial only to some parties of the relationship, and not all parties involved, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In particular, Examiner relies on Covert for the feature of providing benefits to the family after the loss of a member of the family. The combined teachings of the applied art suggest the claimed invention.

It is noted that on page 11 and throughout, Applicant refers to “applicants’ published application”.

Examiner submits that it is improper to refer to versions of the specification not in the Official file due to possible changes made during publication. Therefore, Examiner is only considering the specification in the Official file as Applicant’s disclosure.

See MPEP 1730(II)(B)(1)(d) for information on how to access the Official file. See also the last page of this Office Action for information on how to access the PAIR system.

On page 11 Applicant asserts the advantage of "the policy is contracted and entered into (and premiums have been paid) long before an end (e.g., a divorce) is even contemplated by the contracting persons".

Golden teaches providing divorce insurance to unmarried couples (paragraph 17).

Examiner submits that unmarried couples have not contemplated divorce because they are not married.

Therefore, the asserted advantage does not distinguish the claimed invention from the applied art.

As per claim 12, on page 11 Applicant argues that Covert does not teach certain features.

Examiner submits that Covert was not applied against claim 12. Therefore, whether Covert does or does not teach a feature of claim 12 is immaterial to the rejection.

Similar rationale applies to Applicant's arguments on page 12 regarding claims 6, 7, 13, 19.

As per claim 12, on page 12 Applicant argues that Roberts does not teach "the charges for the periodic payment start either at or before the beginning of the contractual relationship between the two or more natural persons".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., charging the periodic payment before the beginning of the contractual relationship) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Assuming this limitation flows inherently therefrom, Golden teaches providing coverage to unmarried couples (reads on "before the beginning of the contractual relationship") (paragraph 17).

On page 12 Applicant further argues that Roberts does not teach "financial consequence comprise, in addition to legal fees, financial consequences selected from the group consisting of moving costs, a child's education, a former partner's education, health insurance premiums, life insurance premiums, and combinations of any thereof".

Roberts teaches providing insurance coverage for a child's education in the event of the death of a parent (column 3 line 6-16).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per claim 11, on page 12 Applicant argues "with respect to claim 11, applicants reviewed paragraph [0036] of Covert, and were unable to find a third party".

Page 6 of the previous Office Action cites paragraph 0061 of Covert.

Therefore, it is not clear why Applicant is reviewing paragraph 0036 when paragraph 0061 was cited.

As such, whether paragraph 0036 contains this feature or not is immaterial to the rejection.

Applicant's arguments with respect to claims 14-15 on page 12 have been considered but are moot in view of the new ground(s) of rejection.

As per claims 6-7, 19, 13, Applicant's arguments on page 13 merely rehash arguments previously addressed above, and incorporated herein.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Class 705, subclass 4 contains many references directed to automated underwriting, including automatic calculation of insurance premiums.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./  
Examiner, Art Unit 3626  
09/17/2008

/C Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626